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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,928

02/09/2004

Jose A. O'Daly

299 P 010

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05/23/2006

DOCKET ADMINISTRATOR  
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EXAMINER

GRASER, JENNIFER E

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/774,928	Applicant(s) O'DALY, JOSE A.	
	Examiner Jennifer E. Graser	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 21-38 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The Examiner of Record has changed from Patricia Duffy to Jennifer Graser. Applicants cancelled former claims 3-20 which rendered the Species Election between claims 3 and 12 moot; however, the newly submitted claims are subject to the following Restriction Requirement and Species Election.

#### *Election/Restrictions*

- I. Claims 1, 21-29 and 36-38, drawn to a method of using a purified protein product which is 73kDa, classified in class 436, subclass 536.
- II. Claims 1, 21-26, 31, 32 and 36-38, drawn to a method of using a purified protein product which is 80kDa, classified in class 436, subclass 536.
- III. Claims 1, 21-26 and 33-38, drawn to a method of using a purified protein product which is 82kDa, classified in class 436, subclass 536.

The inventions are distinct, each from the other because of the following reasons:

Claim 1 recites a method for selectively inhibit T-cell rolling in a human host which comprises administering **a compound**. Dependent claims recite three compounds which are structurally and biologically distinct, e.g., a 73kDa protein, a 80kDa protein and an 82kDa protein. These three proteins represent different reagents which work in a different manner. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different methods recited in Groups I, II and III utilize completely different reagents with different modes of operation and different effects.

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Because these inventions are distinct for the reasons given above and have recognized divergent subject matter and because the literature search required for the Groups is not coextensive, restriction for examination purposes as indicated is proper.

***Species/Election***

This application contains claims directed to the following patentably distinct species:

If Group I is elected:

SPECIES A: a 73kDa protein comprising SEQ ID Nos: 1, 5 and 6

SPECIES B: a 73kDa protein comprising SEQ ID Nos: 12, 13 and 14.

If Group II is elected:

SPECIES C: an 80kDa protein comprising SEQ ID Nos: 1, 3 and 4.

SPECIES D: an 80kDa protein comprising SEQ ID Nos: 1, 3 and 10.

If Group III is elected:

SPECIES E: an 82kDa protein comprising SEQ ID Nos: 1 and 2.

SPECIES F: an 82kDa protein comprising SEQ ID Nos: 7, 8 and 9.

The species are independent or distinct because each of the methods utilize distinct protein products comprising proteins having different primary structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 21-26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Correspondence regarding this application should be directed to Group Art Unit 1645. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Remsen. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1645 Fax number is 571-273-8300 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Graser whose telephone number is (571) 272-0858. The examiner can normally be reached on Monday-Thursday from 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (571) 272-0864.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0500.

  
Jennifer Graser  
Primary Examiner  
Art Unit 1645